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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,542	12/20/2000	Christof Fattinger	9492	6425

151 7590 04/11/2003
HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY, NJ 07110

EXAMINER

QUAN, ELIZABETH S

ART UNIT	PAPER NUMBER
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1743

14

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/741,542

Applicant(s)

FATTINGER ET AL.

Examiner

Elizabeth Quan

Art Unit

1743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

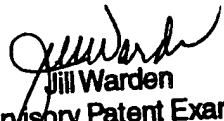
Claim(s) rejected: 1-5.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: Claim 4 recites "means for retaining a sample tube comprise a projection of the inner surface of the wall of each storage compartment is configured and dimensioned so as to bias against a sample tube that is positioned within the storage compartment," which has already been recited in independent claim 1. There is either a 112, 2nd paragraph problem with lack of antecedent basis or claim objection due to failure to limit the base claim or duplicate claim .

Continuation of 10. Other: The secondary reference Verwohlt et al. disclose means for retaining a sample tube (16) within each of the storage compartment (13) in which the retaining means comprises a projection (14) of the inner surface of the wall (12) of each storage compartment (13) in which the projection (14) is suitable for snapping between two ridges of the outer wall of a sample tube (16) that is positioned within the storage compartment (13) (see FIGS. 3 and 4). It is noted that the projection in each of the primary references Schwartz and Leoncavallo are "suitable" for snapping between two ridges of the outer wall of a sample tube that is positioned within the storage compartment. According to Merriam-Webster Collegiate Dictionary, suitable is defined as adapted to or fit for a use or purpose. The projections of Leoncavallo and Schwartz are fit for and have the potential or ability to snap between two ridges of the outer wall of a sample tube that is positioned within the storage compartment. Each of the primary references Leoncavallo and Schwartz provide the teaching for storage compartments capable of receiving sample tubes from both the top and bottom side of the frame with one and the same orientation of the sample tube with respect to the frame; therefore, Verwohlt et al. do not need to provide the teaching since its purpose of the reference is to provide retaining means snapping between two ridges of the outer wall of a sample tube. It is noted that the two ridges and the sampling tube has not been positively recited, and the limitation "said projection being suitable for snapping between two ridges of the outer wall of a sample tube that is positioned within the storage compartment" is a method limitation that has no patentable weight in apparatus claims. Also see response to arguments in the Office Action (Paper #9) mailed 12/126/2002.


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